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| 09/868,619 | 09/25/2001 | Yasuhito Sone | P107390-0000 | 1036 |

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EXAMINER

JABR, FADEY S

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| ART UNIT | PAPER NUMBER |
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3639

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,619

Applicant(s)

SONE, YASUHIITO

Examiner

Fadey S. Jabr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassett et al., U.S. Patent No. 5,144,553 in view of Deaton et al., U.S. Patent No. 6,622,811 B1.

As per **Claim 1 and 2**, Hassett et al. discloses a system for setting the initial available numbers of times of unitary use (P) of prepaid available number-of-times-of-unitary-use storage media (8) for making use of a certain toll or pay service, the initial value-setting system (10) comprising

- a means for receiving purchase-application data on each medium (8) including its purchase date and time (DT) through a communication network (N)

(Col. 4, lines 13-27, 44-48; Col. 17, lines 1-21),

- a storage area for storing the opening date and time (DTS) of advance sale of the media (8), a storage area for storing the closing date and time (DTO) of the advance sale, a storage area for storing the closing date and time (DTE) of ordinary sale, as distinct from the advance sale, of the media (8) (Col. 5, lines 64-4; Col. 16, lines 33-68; Col. 18, lines 10-21), and

- an initial value-setting means for setting the initial numbers (P) of media (8) with purchase dates and times (DT) between the opening and closing dates and times (DTS and DTO) higher than those (P) of media (8) with purchase dates and times (DT) between the closing dates and times (DTO and DTE) (Col. 4, lines 44-61; Col. 16, lines 33-59).

Hassett et al. fails to explicitly disclose setting the initial numbers of media higher with purchase dates during an earlier time period. Nonetheless, Deaton et al. teaches providing incentives for customers who make purchases during earlier time periods (Col. 70, lines 11-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Hassett et al. and offer incentives for customers who made purchases in advance as disclosed by Deaton et al. because it would encourage the customer to purchase the item during the specified time period, and it greatly improves the marketing aspects of the system.

As per **Claims 3**, Hassett et al. fails to explicitly disclose a system which the initial value-setting means sets one and the same number (P) for all media (8) with purchase dates and times (DT) between the opening and closing dates and times (DTS and DTO). Official notice is taken that charging customers who purchase the identical item at the same location during the corresponding time period are billed equally is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Hassett et al. to include the initial value-setting means sets one and the same number for all media with purchase dates and times between the opening and closing dates and times, because Hassett et al. discloses vehicle operators purchasing prepaid

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toll-money-available quantities (Col. 5, lines 64-68), one of ordinary skill in the art would be motivated to do so, because it greatly benefits the system to charge the optimum price determined by economic forces.

As per **Claim 4**, Hassett et al. further discloses

- a system including a storage area for storing a target annual sales (Z) of the media (8), a storage area for storing a selling price (K) of media (8), a storage area for storing a toll (E.sub.0) expressed in a number of times of unitary use of the service, a storage area for storing a most preferential initial number of times of unitary use (A) applicable to media (8) purchased during the advance sale, and a storage area for storing the sales (YT) from the opening date and time (DTS) to the purchase date and time (DT) of each medium (8) (Col. 5, lines 64-68; Col. 16, lines 33-59),

- the initial value-setting means having a function $f.sub.1(DT)$ to calculate the number of days (C) from the closing date and time (DTO) to the purchase date and time (DT) of each media (8), a function $f.sub.2(C, A, E.sub.0)$ to calculate a preferential initial number of times of unitary use (m) at the purchase date and time (DT) of said medium (8) based on the number of days (C), the most preferential initial number of times of unitary use (A), and the toll (E.sub.0), a function $f.sub.3(m, Z)$ to calculate the ratio (X) of the preferential initial number of times of unitary use (m) of said medium (8) to the target annual sales (Z) of the media (8), and a function $f.sub.4(X, YT)$ to calculate the final initial number of times of unitary use (P) for said medium (8) based on the ratio (X) and the sales (YT) at the purchase date and time (DT) of said medium (Col. 17, lines 1-54).

As per **Claim 5**, Hassett et al. further discloses a device which is a computer and provided with the initial value-setting system (Col. 16, lines 60-68; Col. 17, lines 1-21).

As per **Claims 6**, Hassett et al. further discloses a system which sets the initial available numbers of times of unitary use (P) of the media (8) and has a means for transmitting the initial numbers (P), purchase-application-data input devices (2) each to input and transmit purchase-application data on each medium (8) to the initial value-setting device (1) through a communication network N, writing devices (3) each to receive the initial number (P) of each medium (8) from the initial value-setting device (1) through the communication network N and write the initial number (P) in said medium (8), and rewriting devices 4 each to rewrite the remaining available number of times of unitary use of said user's medium (8) every time each user makes use of the service (Col. 78, lines 6-68; Col. 8, lines 1-2, 24-44; Col. 16, lines 33-35, 60-67).

As per **Claim 7 and 8**, Hassett et al. further discloses a system which

- sets the initial numbers of times of unitary use (P) of the media (8) and has a means for transmitting the initial numbers (P) (Col. 16, lines 60-68),
- (ii) mobile communication terminals (5) each including a means for inputting purchase application data on a medium (8) (Col. 4, lines 13-27, 44-48),
- a means for transmitting the purchase-application data on the medium (8) to the initial

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value-setting device (1) through a communication network (N), a means for receiving the initial number (P) of the medium (8) from the initial value-setting device (1) through the communication network (N) (Col. 16, lines 56-68),

- and a means for writing the initial number (P) in the medium (8), and (iii) a rewriting device (4) to rewrite the remaining available number of times of unitary use of said user's medium (8) every time each user makes use of the service (Col. 2, lines 27-30, 41-61).

As per Claim 9, Hassett et al. further discloses a medium for making use of a certain toll or pay service which is a storage medium to be used in the operating system (1) according to claim 6, and has a rewritable storage area of a number of times of unitary use (Col. 2, lines 27-30, 41-61).

3. Furthermore, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd Pat. App. & Inter. 1987). Thus, the structural limitations of claims **1 and 4**, including an initial value-setting system comprising the structural elements of a memory and a processor are disclosed in Hassett et al. as described above. Also, as described above, the functional limitations in claim **1 and 4** do not distinguish the claimed apparatus from the prior art.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Barker et al., U.S. Patent No. 5,144,553

b. Slavin et al., U.S. Patent No. 5,819,234

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

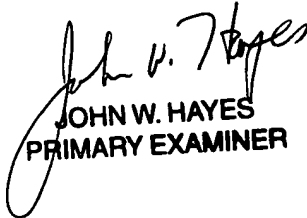
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fadey S Jabr
Examiner
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FSJ


JOHN W. HAYES
PRIMARY EXAMINER